

REMARKS

Applicant has carefully studied the Office Action of March 10, 2005, and offers the following remarks in response thereto.

Claims 1-12 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Applicant respectfully traverses. The Patent Office sets forth a two part test as the basis of the rejection, indicating that to be statutory, the claim must be within the technological arts and produce a useful, concrete, and tangible result. Applicant notes that this articulated standard is not supported with a citation to any case law or a relevant portion of the MPEP. Applicant has not been able to locate a corresponding two prong test in the MPEP, and this standard thus appears to have been fabricated by the Patent Office.

Applicant notes that 35 U.S.C. § 101 permits patents to be granted for "any new and useful process. . ." "Process" is defined in 35 U.S.C. § 100 as including a use of a machine. Claim 1 recites receiving a request initiated by a mobile terminal. A mobile terminal is a machine. As the claim recites the use of a machine, the claim satisfies the requirements for being statutory subject matter as defined by the statute. Applicant notes that the Patent Office's own characterization of the subject matter of the claims shows that a machine is used. Specifically, the Patent Office opines that the steps constitute an idea of identifying available parking locations "via a wireless communication system." (emphasis added). To the extent that a wireless communication system is a machine, this characterization also satisfies the statutory requirements. Therefore, Applicant requests withdrawal of the § 101 rejection of claims 1-12 at this time.

If recent case law has provided gloss to the statute that is not readily apparent from reading the text of the statute in the form of the test set forth by the Office Action, the claims still meet the test.

Specifically, with respect to the first prong, the Patent Office asserts that claim 1 does not require any technology, and further asserts that the steps can be done with no technology at all. This assertion is demonstrably false. The claims recite a mobile terminal. Specifically, claim 1 recites: "receive a request initiated by the mobile terminal and effect delivery of parking information to the mobile terminal". Since the mobile terminal is a piece of technology, the reception therefrom and the delivery thereto constitutes a use of a technological art. Thus, claim 1 satisfies the first prong of the test set forth by the Patent Office.

Claim 1 also satisfies the second prong in that it produces a concrete or tangible result. Specifically information is delivered to the mobile terminal. This is a tangible result under the relevant standards set forth by the Federal Circuit. *State Street Bank & Trust Co. v. Signature Financial Group*, 149 F.3d 1368 (Fed. Cir. 1998) (holding that the transformation of data, representing discrete dollar amounts, through a series of mathematical calculations, into a final share price, constitutes a practical application of a mathematical algorithm, formula or calculation). Thus, claim 1 produces as tangible a result as that set forth in *State Street* and constitutes statutory subject matter. Applicant requests withdrawal of the § 101 rejection to claims 1-12 at this time for this reason as well.

Claims 1-37 were rejected under 35 U.S.C. § 112, second paragraph as being indefinite. Applicant respectfully traverses. During examination, the examiner's focus should be on whether the claims meet the threshold requirements for clarity and precision, not whether more suitable language or modes of expression are available. MPEP § 2173.02. All that is required is a reasonable degree of particularity and distinctness. *Id.* Definiteness of claim language is analyzed in light of: (a) the content of the particular application disclosure; (b) the teachings of the prior art; and (c) the claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made. *Id.*

The Patent Office's first basis of rejection for claims 1-37 is demonstrably false and should be withdrawn. Specifically, the Patent Office asserts that the claims recite the limitation "a mobile terminal" in "parking", and further asserts that there is insufficient antecedent basis for this limitation. While the claims do recite both "mobile terminal" and "parking", all recitations of both elements have proper introductions and antecedent basis. As such, this § 112 rejection is improper, and Applicant requests that it be withdrawn.

Claim 1 was rejected because it recites "available". The Patent Office provides a definition of "available" as "present or ready for immediate use", but then states "there is no step of 'intermediate use' in the method. . . ." Applicant is unsure as to what relevance any intermediate use would have on the claims. Claim terms are given their ordinary meaning in the absence of a definition in the specification. MPEP § 2111.01. The Patent Office's definition is not attributed to any source, but assuming, *arguendo*, that the definition is reasonable, Applicant fails to see any problem with the claims. The Patent Office concludes that steps (a) through (d) are vague and asks how step (a) is carried out.

Applicant notes that while the claim is broad about the manner in which the receiving of step (a) is carried out, there is no ambiguity associated with the claim language. Someone of ordinary skill in the art, having read the specification, would readily understand various ways in which the recited receiving could occur. In the absence of a more readily identified problem with the claim, claim 1 is sufficiently definite to satisfy the requirements set forth in 35 U.S.C. § 112, second paragraph. Applicant requests withdrawal of the § 112 rejection of claim 1 at this time.

Claim 13 was rejected because it recites a system. The Patent Office defines "system" and "network", again without attribution of the source of those definitions. The Patent Office asserts that there is no positive language showing a relationship between the functional components. This assertion is demonstrably false. The claim recites that the control system is associated with the network interface. "Associated with" constitutes a relationship between the two functional components: a network interface and a control system. Thus, the claim meets the definition set forth by the Patent Office for a "system". The Patent Office's definition of "network" ignores that "network" in the claim is an adjective that modifies "interface". Thus, the element is an interface, which happens to be a network interface. As such, there does not need to be a step of "associated devices that are connected by communication facilities", as argued by the Patent Office. Since the claim is sufficiently definite that someone of ordinary skill in the art would understand the scope of the claim after having read the specification, the claim meets the requirements for 35 U.S.C. § 112, second paragraph. Applicant requests withdrawal of the § 112 rejection of claim 13 at this time.

Claim 25 was rejected because it recites "computer readable". Specifically, the Patent Office asserts that computer readable means "acted on a compiler", and that there is no compiler in the claim. No compiler is needed in the claim to make the claim definite. The claim is sufficiently definite to someone of ordinary skill in the art to meet the requirements of 35 U.S.C. § 112. Applicant requests withdrawal of the § 112 rejection of claim 25 at this time.

Applicant further notes that the claim drafting presented in claims 1-37 represents standard claim drafting practice in the electrical and computer industries. Countless patents have issued with claims that are similar in grammatical structure to the claims presented herein. If the Patent Office disagrees, Applicant requests an interview with the Examiner and Supervisory

Examiner to discuss the nature of this rejection, because the Office Action does not set forth a sufficient basis to maintain the rejections under 35 U.S.C. § 112.

Claims 1-37 were rejected under 35 U.S.C. § 102(e) as being anticipated by Curbow et al. (hereinafter "Curbow"). Applicant respectfully traverses. 35 U.S.C. § 102(e) requires that the invention was described in the reference before the invention by the application for patent. Applicant's invention predates Curbow and thus, Curbow is not available under 35 U.S.C. § 102(e).

Specifically, Applicant submits a declaration under 37 C.F.R. § 1.131 by the inventors showing proof of conception and diligence to filing from a date before October 17, 2001, the priority date of Curbow. Since Applicant's date of invention predates Curbow's priority date, and Applicant has exercised diligence in constructive reduction to practice, Curbow is not available as prior art. Since Curbow is not available as prior art, a rejection based thereon is improper. Applicant requests withdrawal of the § 102 rejection of claims 1-37 at this time.

Applicant requests reconsideration of the rejections in light of the remarks and declaration provided herein. Curbow is not prior art and the § 101 and § 112 rejections are not proper. Applicant earnestly solicits claim allowance at the Examiner's earliest convenience.

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<u>6.10.05</u>	_____ Date of Transmission

Respectfully submitted,

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Date: June 10, 2005
Attorney Docket: 7000-112